

REMARKS

With entry of this amendment, claims 67-94 remain pending, all of which stand rejected. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Rejections-35 U.S.C. §112

Claims 71-75 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite "for failing to recite a positive structural limitation." Applicant respectfully traverses this rejection.

In particular, Applicant is not aware of any requirement in the MPEP requiring a dependent apparatus claim to recite a so-called structural limitation. Indeed, the MPEP specifically allows functional language, stating:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

* * *

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (See MPEP §2173.05(g)).

In the present case, Applicant has used functional language in defining the invention of claims 67 and 76, and has further limited this functional language in claims 85 and 91. That is, claims 67 and 76 require that the deployed first and second electrode arrays be configured to necrose a volume of tissue therebetween when electrical energy is applied between the first and second electrode arrays. Claims 85 and 91 further define the specific

volume of tissue that these electrode arrays are configured to necrose, and thus, further limit claims 67 and 76.

Thus, Applicant submits that claims 85 and 91 are definite, and as such, respectfully requests withdrawal of the §112 rejection of these claims.

Claim Rejections-35 U.S.C. §102

Claims 67-71, 74-84, 86-77, 80-90, and 92-94 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,090,105 issued to Zepeda (“Zepeda”). Without acquiescence that Zepeda is, in fact, a §102(e) prior art reference, and without prejudice to antedate this reference should it become necessary, Applicant traverses this rejection, since Zepeda does not disclose each and every element of these claims, amended.

In particular, independent claims 67 and 71 have been amended to require the at least one electrode of the first array to be configured to initially deploy from the shaft in the distal direction and the at least one electrode of the second array to be configured to initially deploy from the shaft in the proximal direction. The Examiner has referred to the Fig. 9 embodiment of Zepeda as disclosing every element of these claims. However, the second electrode array 16 featured in the Fig. 9 embodiment (i.e., the proximal-most array) initially deploys from the shaft in the distal direction—not in the proximal direction.

Thus, Applicant submits that independent claims 67 and 76, as well as the claims depending therefrom (68-71, 74, 75, and 77-84, 86-77, 80-90, and 92-94), are not anticipated by Zepeda, and as such, respectfully request withdrawal of the §102 rejection of these claims.

Claim Rejections-35 U.S.C. §103

Claims 72, 73, 78, 79, 85, and 91 stand rejected under 35 U.S.C. §103, as being obvious over Zepeda. Applicant respectfully traverses this rejection, since Zepeda does not disclose, teach, or suggest the combination of elements required by these claims.

In particular, as discussed above, the proximal-most electrode array of the Fig. 9 embodiment of Zepeda does not initially deploy from the shaft in the proximal direction, as required by independent claims 67 and 76 from which these claims depend. Thus, Applicant believes that claims 72, 73, 78, 79, 85, and 91 are not obvious over Zepeda, and as such, respectfully request withdrawal of the §103 rejection of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

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